

IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF TEXAS  
HOUSTON DIVISION

CLONTECH LABORATORIES, INC.,

Plaintiff,

v.

BAYLOR COLLEGE OF MEDICINE and  
BCM TECHNOLOGIES, INC.,

Defendants.

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Civil Action No. H02-0017

**COVENANT NOT TO ASSERT U.S. PATENT NO. 5,851,808  
AGAINST CLONTECH LABORATORIES, INC.**

Whereas, defendant Baylor College of Medicine is the assignee of U.S. Patent No. 5,851,808 (the "'808 Patent").

Whereas, Invitrogen Corporation ("Invitrogen") is the exclusive licensee of the '808 patent.

Whereas, this declaratory judgment action relating to the '808 Patent, filed on January 4, 2002, by plaintiff, Clontech Laboratories, Inc. ("Clontech"), against the defendants, Baylor College of Medicine and BCM Technologies, Inc. (collectively "Baylor") sought a declaratory judgment that Clontech did not infringe the '808 Patent and/or that the '808 Patent was invalid (Docket No. 1).

Whereas, Baylor moved to dismiss the complaint under Fed. R. Civ. P. 12(b)(1) for lack of subject matter jurisdiction on the ground that there was no case or controversy between the parties (Docket No. 12).

**EXHIBIT A**

Whereas, on February 6, 2003, this Court denied that motion, finding, *inter alia*, that Baylor has not assured either this Court or Clontech that it will not bring an infringement suit against Clontech (Docket No. 31).

Now, therefore, Baylor and Invitrogen hereby covenant not to assert the '808 Patent against Clontech with respect to its past Creator™ products, and existing Creator™ products as of the date of this covenant. This covenant is without prejudice to Baylor and Invitrogen's right to assert the '808 Patent against other parties. This covenant also is without prejudice to any other patents, including continuations, continuations-in-part, divisionals, reissue, and reexamined patents, as well as foreign counterparts.

Dated this 20th day of March, 2003.

AGREED:



David P. Blanke  
Attorney-in-Charge  
State Bar No. 02453600 (SD No. 28946)  
Tracey Davies  
State Bar No. 24001858  
M. Michelle Muller  
State Bar No. 24037155  
VINSON & ELKINS L.L.P.  
The Terrace 7  
2801 Via Fortuna, Suite 100  
Austin, Texas 78746-7568  
Tel: (512) 542-8400  
Fax: (512) 542-8612

Jason M. Powers  
State Bar No. 24007867 (SD No. 23567)  
David K. Wooten  
State Bar No. 24033477 (SD No. 30375)  
VINSON & ELKINS LLP  
1001 Fannin Street  
Suite 2300  
Houston, TX 77002-6760  
Tel: (713) 758-2222  
Fax: (713) 758-2346

Attorneys for Defendants Baylor College of  
Medicine and BCM Technologies, Inc. and  
Non-Party Invitrogen Corporation

#3672156

Notice: The attached order has been entered.



Kevin M Bell 4:02-cv-00017 35 aty  
Patton Boggs LLP  
8484 Westpark Dr  
Ste 900  
McLean, VA 22012

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4:02-cv-00017 #35  
5 page(s).  
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United States District Clerk  
P. O. Box 61010  
Houston, TX 77208

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